

REPLY TO FINAL OFFICE ACTION OF 07/12/2004

SERIAL NO: 09/990,770
DOCKET NO: 149-0046US**REMARKS**Claims

Claims 1-45 were pending. No claims have been amended, added or canceled in this Reply.

102 rejections

Claims 1-45 were rejected under section 102 in view of Leung (USP 6,282,570) in the Office Action dated 2/13/2004. Applicant's Reply, dated 4/5/2004 (the "4/5 Reply") pointed out the lack of teaching in Leung for many limitations required by the claims. See 4/5 Reply at pages 12-13.

Applicant reminded the Examiner that in a valid section 102 rejection, "[t]he identical invention must be *shown in as complete detail as is contained in the patent claim.*" *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir.), *cert. denied*, 493 U.S. 853 (1989); see also M.P.E.P. 2131. Further, the "*elements must be arranged as in the claim under review.*" *In re Bond*, 910 F.2d 831, 832 (Fed. Cir.), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (1990); see also M.P.E.P. 2131. See 4/5 Reply at page 13. Furthermore, "[f]or a prior art reference to anticipate in terms of 35 U.S.C. 102, *every* element of the claimed invention must be *identically* shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 (Fed. Cir. 1988), quoted in *In re Bond*, 910 F.2d 831, 832 (Fed. Cir.), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (1990) (vacating and remanding Board holding of anticipation); see M.P.E.P. 2131

In the current final Office Action ("FOA"), the Examiner has repeated the rejections identified in the Office Action dated 2/13/2004. For example, in rejecting claim 1, regarding the first clause, the examiner copied the claim language and then cited text from Leung, but provided no explanation as to how the cited text "[shows] as complete detail as is contained in the patent claim," or identically shows every element of the claimed invention. The Examiner asserts:

"As to claims 1, 16, and 31, determining actions to be performed on one or more database objects to modify the one or more database objects, wherein a database

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comprises the one or more database objects; See Abstract; 4:1-25; 5:21-55; 8:41-65; 10:22-54;" FOA at page 3.

Applicant submits that the cited text from Leung does not show "in as complete detail as is contained in the patent claim," nor does it show identically every element of the claimed invention, nor is it "arranged as in the claim under review." Applicant submits that for these reasons alone, the rejections against claims 1, 16 and 31 are improper. Claims 1, 16 and 31 are not anticipated or made obvious by Leung for the reasons set forth in Applicant's 4/5 Reply and for their failure to identify each claimed element as noted herein. They are allowable and their allowance is requested.

In response to Applicant's 4/5 Reply, the Examiner asserts:

"Applicant argues that Leung does not teach specific automated sequence of action such as monitoring results of the performing the actions on the database objects; and reconfiguration one or more policies or definitions associated with database based on the monitoring the results of the performing the action on the database objects." FOA at page 7.

Applicant disagrees. In the 4/5 Reply, Applicant argued that Leung does not teach each and every limitation in claim 1 and other claims. "A specific automated sequence of action" is but one limitation among many limitations. See 4/5 Reply at page 13, and more discussion below.

The Examiner further asserts: "In response, Examiner maintains that Leung teaches such wherein data is collected on database nodes and resource constraints are changed based on database activity are deemed to provide Applicant's limitations." FOA at page 7.

It is not clear how and where Leung teaches "wherein data is collected on database *nodes* and *resource constraints* are changed based on database *activity*." (Emphasis added.) Assuming, *arguendo*, that Leung does teach such, it is not clear how "data is collected on database nodes and resource constraints are changed based on database activity" is related to any limitation of claim 1. Four actions (determining, performing, monitoring and reconfiguring) are recited in claim 1 and the actions are performed on various objects (database objects, results of

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performance, policies etc.). There is no recitation of "database nodes" or "resource constraints" in claim 1. More specifically, claim 1 recites:

"[1]*determining* [2]*actions to be performed* on one or more [3]*database objects* to [4]*modify* the one or more [3]*database objects*, wherein a [5]*database* comprises the one or more *database objects*;

[2]*performing the actions* on the [3]*database objects*;

[6]*monitoring* [7]*results* of the [2]*performing the actions* on the [3]*database objects*; and

[8]*reconfiguring* one or more [9]*policies* or [10]*definitions* associated with the [5]*database* based on the [6]*monitoring* the [7]*results* of the [2]*performing the actions* on the [3]*database objects*." ([numbers] are added to clarify the claim limitations.)

Applicant submits that Leung does not teach or fairly suggest each and all of the identified ten (10) limitations. The Examiner has not identified each and all of these limitations in Leung either.

For these reasons, in addition to the reasons discussed in Applicant's 4/5 Reply, claim 1 is not anticipated or made obvious by Leung. Therefore, claim 1 is allowable and its allowance is requested.

Independent claims 16 and 31 have at least the same limitations as independent claim 1, and are, therefore, allowable in view of Leung for at least the same reasons.

All dependent claims depend from one of independent claims 1, 16 or 31, and are, therefore, also allowable. Their allowance is requested.

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Reconsideration of the pending claims 1-45 in light of the above remarks is respectfully requested. If, after considering this reply, the Examiner believes that a telephone conference would be beneficial towards advancing this case to allowance, the Examiner is strongly encouraged to contact the undersigned attorney at the number listed.

10/7/2004

Date



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